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Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, some of the claims are amended and claims 13 and 14 are added. These amendments to the claims constitute a bona fide attempt by applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Claims 7, 9, 10 and 12-14 are pending.

Claim Rejections - 35 U.S.C. §103

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." Emphasis added.

The Examiner rejected independent claim 7 under 35 U.S.C. 103 as being obvious based on Bodic et al. (U.S. Patent Application 2003/0040300) in view of Muhonen (WO 99/66746). Applicants respectfully submit that the applied references, with or without modification or combination, assuming, *arguendo*, that the modification or combination of the applied references is proper, does not teach or suggest one or more elements of the claimed invention, as further discussed below. Applicant respectfully traverses the rejections and seeks withdrawal of the rejections resulting in allowance of the application.

The method of claim 7 is directed to delivering at least a portion of a multimedia message to a non-MMS enabled handset. A multimedia message containing a voice portion is received and stored at a message server in a mailbox assigned to a recipient of the multimedia message. A

determination is made if the recipient uses a handset that can receive a short message service, SMS, message. If the recipient utilizes an SMS enabled handset, an SMS notification message is generated and transmitted to the recipient's handset. The notification message communicates to the recipient that a voice message is awaiting delivery. Upon receipt of an independent, conventional voice channel cellular call from the recipient at the message server, the voice portion of the information is transmitted to the recipient utilizing a voice channel communication mode supported by the conventional voice channel cellular handset of the recipient. It will be noted that the recipient retrieves the stored voice message over a conventional voice channel using the conventional cellular handset of the recipient.

In the Office Action claim 7 was rejected on a combination of the teachings of Bodic and Muhonen.

Bodic is generally directed to a system that supports the interoperability of MMS messages and SMS/EMS messages. Bodic operates as a translator/director for a message of one type so that it can be delivered to a handset that receives messages of the other type, but not the one type. Bodic does not address or teach a solution involving the delivery of conventional voice mail. That is, it is important to distinguish between conventional voice channel transmission of voice mail comprising spoken words stored in a conventional voice mailbox and "messages" as discussed in Bodic. The purpose of Bodic is to analyze and potentially redirect/translate a transmitted message of one type into a message of another type of message that the recipient's handset is capable of receiving. A spoken communication that is stored as voice mail does not constitute a "message" as discussed in Bodic, i.e. the stored voice mail is neither an MMS message nor an SMS message. Bodic does not teach or suggest the transmission of the spoken words of a stored voice mail over a conventional voice channel to a cellular telephone handset.

In Bodic incoming messages are received by a message gateway which consults its profile table to determine whether the incoming message is an EMS or SMS type message. That as, one of ordinary skill the art would understand that the message being handled in Bodic is either an EMS

or SMS message that is to be transmitted to a destination recipient. A conventional stored voice mail is neither an EMS or SMS message.

With regard to the rejection of claim 7, Muhonen (page 16, lines 18-22) is relied upon to support the teaching of the transmission of the message to the handset of the recipient. This portion of Muhonen recites:

When the multimedia message service Center MMSC has found the message it sends to the mobile station MS for the serving support node SGSN the contents of the message or if the message is so long that it has to be divided into segments the first segment thereof

It is apparent from this text as well as FIG. 6 of Muhonen that the transmission of the stored information to the recipient is made by one or more serially transmitted packets of digital data. That is, Muhonen does not teach or suggest the ability to transmit a stored voice message over a conventional cellular voice channel as conventional spoken information to the cellular handset of the recipient.

Therefore, neither Bodic nor Muhonen provide a teaching of all the claim limitations required by independent method claim 7. The withdrawal of the rejection of claim 7 is requested.

Independent apparatus claim 10 is believed to be allowable for reasons similar to those explained above with regard to claim 7.

New claims 13 and 14 or specifically recite that the voice portion is the representation of spoken words by a calling party and that the voice portion is stored in a conventional voice mailbox in the message server associated with the recipient. It is believed that these limitations further serve to patently distinguish subject matter of the parent claims.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349

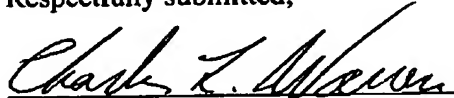
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(CCPA 1959) Both Bodic and Muhonen include as a principle of operation the concept of transmitting information to a recipient handset as one or more data packets. Assuming arguendo that a further reference was cited relating to a conventional voice mailbox, an attempt to incorporate such a teaching with the teachings of Bodic and/or Muhonen would change the principle of operation of Bodic and Muhonen. Hence, in accordance with this legal requirement, such a combination of teachings would not render the subject matter of the present invention prima facie obvious.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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